DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: In line 3, "interleaved with cam arms of lower" should be –interleaved with the cam arms of the lower--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 requires "a valveable passage". It is not understood what a "valveable passage" is. Claim 17 includes trademarks. Claim language cannot use trademarks in that trademarks are subject to change and do not positively recite the subject matter being claimed.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-14, 21-33, 39-43 and 46-49 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14, 15-27, 28-32 and 33-36 of copending Application No. 10/507567. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1-14, 21-33 and 39-42 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14, 15-27 and 28-31 of copending Application No. 10/495347. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 46-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 40-42 of copending Application No. 10/495347. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the instant claims call for supporting the tubular member using a collapsible expansion device. The claims 10/495347 state supporting the tubular member using an adjustable expansion device. It would have been considered obvious to use a collapsible expansion device as the adjustable expansion device in the claims of 10/495347.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 44 and 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 66 and 69 of copending Application No. 10/507567. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims call for displacing the expansion device using fluid pressure and the claims of 10/507567 just call for displacing the expansion device. It would have been considered obvious to displace the expansion device of 10/507567 using fluid pressure.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Lloyd et al 2007/0144735

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The instant claims are fully disclosed in Lloyd et al. Lloyd discloses an upper and lower support tubular, 14006; cup seals 22, upper cam 14052 having arms 14052d, lower cam 14060, a tubular base, lower cam arms, the upper and lower cam arms being interleaved. As to claim 11, a stop member 18060 is provided. As to claim 12, a float shoe 4512 is provided.

Allowable Subject Matter

Claims 15-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Election/Restrictions

Applicant's election with traverse of claims 1-33 and 39-49 in the reply filed on 3/11/08 is acknowledged. The traversal is on the ground(s) that the restriction was made under PCT rules and not US rules. This is not found persuasive because this

application is a 371 case. Restriction requirements in 371 cases must be made using PCT rules.

The requirement is still deemed proper and is therefore made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William P Neuder/
Primary Examiner
Art Unit 3672

W.P.N.